UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,582	03/08/2001	Matthew S. Chang	450103-02818	4866

20999 7590 11/05/2004

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER	
FISH, JAMIESON W	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/801,582	CHANG ET AL.	
	Examiner	Art Unit	
	Jamieson W. Fish	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03/08/2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/8/01*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS), filed on 03/08/2001, has been placed in the application, and the information referred to therein has been considered as to the merits.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims **1-9, 11-13, 16-20** are rejected under 35 U.S.C. 102(e) as being anticipated by Ngo et al. (US #6,574,793).

4. Regarding claim **1**, Ngo et al. teaches a method for displaying a television commercial on end user equipment, comprising the steps of: providing a plurality of commercials available to be played on said end user equipment while said equipment is tuned to a television channel (see Fig. 2, plurality of commercials 20, and Col. 3 line 27-29), detecting the onset of a commercial time slot on said television channel (see Fig 2, break in program 22 and see Col. 3 line 27-29); selecting, at said end user equipment,

one of said plurality of commercials(see Fig. 8, icons for choosing commercials 56 and 58, and Col. 4 lines 18-24); and playing said selected one of said plurality of commercials on a display during said detected commercial slot as a substitute for a commercial broadcast on said television channel, while said end user equipment remains tuned to said television channel (See Figs. 2,8 and Col. 3 lines 26-34, Col. 5 lines 4-7).

5. Regarding claim **2**, Ngo et al. teaches a method of displaying advertisements further comprising selecting step performed by an end user selecting among said plurality of commercials (see Fig. 8, icons for choosing commercials 56 and 58, and Col. 4 lines 18-24).

6. Regarding claim **3,** Ngo et al. teaches a method of displaying advertisements further comprising selecting step performed by an end user selecting among said plurality of commercials further comprising simultaneously displaying of at least two of commercials, each on a respective portion of said display, wherein said selecting step is performed by the end user selecting one of the displayed commercials (See Fig. 9 plurality of commercials 80,82,84,86, display 44, and Col. 6 lines 44-50).

7. Regarding claim **4**, Ngo et al. teaches a method of displaying advertisements further comprising customizing plurality of commercials for a particular end user (See Col. 6 lines 55-56).

8. Regarding claim **5**, Ngo et al. teaches a method of displaying advertisements further comprising one commercial being selected based upon a user profile (See Col. 6 lines 57-65).

9. Regarding claim **6**, Ngo et al. teaches a method of displaying advertisements further comprising one commercial being selected based at least upon a prior viewing history of an end user (See Col. 6 lines 65-67 and Col 7 lines 1-6).

10. Regarding claim **7**, Ngo et al. teaches a method of displaying advertisements further comprising one commercial being selected based at least upon a prior commercial selection history of an end user. (See Col. 6 lines 65-67 and Col 7 lines 1-6).

11. Regarding claim **8**, Ngo et al. teaches a method of displaying advertisements further comprising plurality of commercials being pre-stored on a storage medium at an end user location (See Fig. 3, Set Top Box 38, and Col.6 lines 50-52).

12. Regarding claim **9**, Ngo et al. teaches pre-storing on a storage medium at an end user location further comprising storage medium being located in a set-top box (See Fig. 3, Set Top Box 38, and Col.6 lines 50-52).

13. Regarding claim **11**, Ngo et al. teaches pre-storing on a storage medium at an end user location further comprising storage medium being selected from the group consisting of a hard disc drive, a DVD, a CD, flash memory, EEPROM and a floppy disc (See Fig. 3, Set Top Box 38, and Col.6 lines 50-52).

14. Regarding claim **13**, Ngo et al. teaches a method of displaying advertisements further comprising plurality of commercials being stored at a remote location, and are transmitted to the end user equipment to be played thereat (See Fig. 3, cable network system 30, and Col. 3 lines 66-67, Col. 4 lines 1-3, and Col. 6 lines 50-51)

15. Regarding claim **16,** Ngo et al. teaches an apparatus for displaying a television commercial on end user equipment having a television receiver, comprising: a storage device for storing a plurality of commercials received by said user equipment (See Fig. 4, Set Top Box 38 and Col. 6 lines 50-52), a detecting device for detecting the onset of a commercial slot on a broadcast of a television channel to which the television receiver is tuned (See Fig 4, Set Top Box 38 and Col. 4 lines 4-7), and a selector for selecting one of said plurality of commercials stored on said storage device to be displayed on said user equipment during said detected commercial time slot as a substitute for a commercial broadcast on said television channel, while said television receiver remains tuned to said television channel(See Fig. 4, Remote 42, and Col. 3 lines 26-34, Col. 4 lines 7-11, Col. 5 lines 4-7).

16. Regarding claim **17**, Ngo et al. teaches an apparatus for displaying a television commercial on end user equipment having a television receiver further comprising means for receiving a user input for selecting said one commercial (See Figs. 4, buttons 40, remote control 42, and Col. 4 lines 4-15).

17. Regarding claim **18**, Ngo et al. teaches means for receiving a user input for selecting one commercial further comprising means for simultaneously displaying at least two of said commercials, each on a respective portion of a display of said user equipment, and for receiving said user input as a selection of one of said simultaneously displayed commercials (See Fig. 9 and Col. 6 lines 44-50).

18. Regarding claim **19,** Ngo et al. teaches an apparatus for displaying a television commercial on end user equipment having a television receiver further comprising

means for automatically selecting one commercial based upon at least one of a user profile and default information (See Col. 6 lines 55-67 and Col. 7 lines 1-14).

19. Regarding claim **20**, Ngo et al. teaches a means for automatically selecting one commercial based upon at least one of a user profile and default information further comprising means for updating a user profile based on commercial selections made by the end user (See Col. 6 lines 55-67 and Col. 7 lines 1-14).

Claim Rejections - 35 USC § 103

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

22. Claim **10, 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo et al. (US # 6,574,793) in view of Eldering et al (US 2002/0026638).

23. Regarding Claim 10, Ngo et al. teaches pre-storing on a storage medium at an end user location further comprising storage medium being located in a set-top box (See Fig. 3, Set Top Box 38, and Col.6 lines 50-52). Ngo discloses storing on a disc and not a hard disc drive. Eldering et al. teaches a STB with a hard disc drive for storing advertisements (See Paragraph 54) It would have been obvious to one skilled in the art to combine the teachings of Ngo et al. with Eldering et al. to store advertisements on a hard disc drive of a STB, in order to locally store a larger number of advertisements.

24. Regarding Claim 12, Ngo et al. teaches pre-storing on a storage medium at an end user location further comprising downloading a plurality of commercials to a set top box (See Fig. 10, downloads ads to set top box 82, and Col.6 lines 50-52). Ngo does not specify that the advertisements will be periodically replaced. Eldering teaches storing advertisements for an electronic program guide to a STB and periodically replacing the advertisements (See Paragraphs 65 and 66). It would have been obvious to one skilled in the art to combine the teachings of Ngo and Eldering to store a plurality of advertisements on a STB and to periodically replace said plurality of commercials stored on the storage medium, in order to refresh the ads periodically so the user could view different ads.

25. Claim **14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo et al. (US # 6,574,793) in view of Levitan et al. (US 2002/0073421 A1).

26. Regarding Claim 14, Ngo et al. teaches a method of displaying advertisements further comprising of selecting step being performed by an end user (See Fig. 8, icons

for choosing commercials 56 and 58, and Col. 4 lines 18-24). Ngo also teaches storing information identifying the number of times a commercial was viewed (See Col.6 line 67 and Col. 7 lines 1-5) and displaying advertisements further comprising one commercial being selected based upon a user profile (See Col. 6 lines 57-65). Ngo does not teach a method of the end user the selecting among the plurality of commercials to be excluded from further viewing, such that a substitute commercial is played as said selected commercial immediately following the exclusion selection, and further comprising storing information identifying the commercial selected to be excluded. Levitan et al. teaches a method of the end user selecting among the plurality of commercials to be excluded from further viewing (See Paragraph 4), such that a substitute commercial is played as said selected commercial immediately following the exclusion selection (See Paragraph 5), and further comprising storing information identifying the commercial selected to be excluded (See Paragraph 18). It would have been obvious to one skilled in the art to combine Levitan's teaching of allowing the viewer to exclude all programming content, including commercials, he deems useless or unacceptable, and storing this information in a user profile, with Ngo's teachings of displaying an advertisement based on information in a user profile, therefore allowing the end user to select among the plurality of commercials to be excluded from further viewing.

27. Claim **15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo et al. (US # 6,574,793) in view of Chapin et al. (US 20030037332 A1).

28. Regarding Claim 15, Ngo et al. teaches a method of displaying advertisements further comprising storing information pertaining to the number of times a particular

commercial has been played at a particular user's equipment (See Col.6 line 67 and Col. 7 lines 1-5). However, Ngo does not specify that this information could be used to charge an advertiser in accordance with the number of plays. Chapin et al. teaches a method of charging advertisers based on the number of times users interact with an advertisement (See Paragraph 13). It would have been obvious to one skilled in the art to modify Ngo's method of storing information pertaining to the number of times a particular commercial has been played at a particular user's equipment with Chapin's method of charging advertisers based on the number of times a commercial was interacted with, to develop a method of charging an advertiser in accordance with the number times a particular commercial was played as an alternative to the traditional methods of charging advertisers.

Conclusion

29. Any inquiry concerning this communication should be directed to Jamieson W. Fish at telephone number 703-305-0884. The examiner can normally be reached on Mon.- Fri. from 8:00 am to 5:00.

30. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Andrew Faile can be reached at 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-308-5359.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600